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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,242	03/06/2002	Benjamin Gebhart	24876-A	8044

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EXAMINER

FORD, JOHN K

ART UNIT	PAPER NUMBER
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3753

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/087,242	Applicant(s) GEBHART, BENJAMIN	
	Examiner John K. Ford	Art Unit 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/30/04
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 5, 8, 10-33 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 17-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 5, 8, 10-16 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's supplement response of June 30, 2004 has been given careful consideration. While it is styled as a supplemental response and amendment, it does not appear any amendment was undertaken. If the Examiner is in error about this, please contact him immediately as there would appear to be missing paperwork in the Examiner's file.

Regarding the June 8, 2004 interview the Examiner does not remember agreeing to no further response being necessary if the issues raised were "identical" to those previously raised before the Board. Moreover, the Examiner remembers counsel agreeing in the interview to contact applicant to expedite the production of the requested information regarding the exact nature of the surface and aging of that surface whose performance is illustrated in Figure 16 of applicant's drawings. No supplemental response has been forthcoming in the interim.

The issues raised here are not the same let alone "identical" or even "substantially identical." Most of the claims at issue here lack the limitation that the "reversal of trend of less than 2 degrees C and without a temperature overshoot on the initial ascent" (i.e. claims 2, 5, 10-16 and 37) and, in the previously decided appeal, that limitation was the only one that Board explicitly identified as not being found in the prior art. Thus applicant may have a "res judicata" argument as to claim 8 and possibly 37, but only as to claim 8 and possibly 37. The other claims lack the only limitation that the Board identified as not found in the prior art. To avoid this issue entirely the Examiner withdraws the rejection of claims 8 and 37 at the present time, pending the additional information that applicant will be providing regarding the exact nature of the surface and

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aging of that surface whose performance is illustrated in Figure 16 of applicant's drawings.

Request for Information

Pursuant to Rule 56 and Rule 105 the Examiner is again requesting that applicant disclose to the Examiner and the PTO precisely which surface and surface treatment was used in the test that generated the performance data found in applicant's Figure 16 labeled Marto and Lepere (1982). Was it the performance of the Thermoexcel-E surface or some other surface with the C and/or D aging treatment or was it the Thermoexcel-E surface or some other surface with some other aging treatment. A copy of the first office action detailing this request is repeated here.

The fundamental question of whether or not applicant's Figure 16 in graphically depicting the Marto and Lepere prior art (as a solid line) is a true and accurate representation of the prior art Thermoexcel –E surfaces following surface aging C and D remains the central question of this examination. It is that there is only one Marto and Lepere performance curve illustrated in applicant's Figure 16 when Marto and Lepere tested three different enhanced surfaces:

1. Union Carbide High Flux surface,
2. Hitachi Thermoexcel – E surface and
3. Wieland Gewa – T surface,

and each if these surfaces was aged at least three different ways. There are then at least nine different possible surface performances of the Marto and Lepere prior art that Applicant could have tested, yet Applicant's Figure 16 shows that only one

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surface performance was tested and it cannot be determined from the disclosure which Marto and Lepere surface with which surface aging was tested.

Before the Examiner reviews ^{to} counsel's requests, either withdraw the rejection or schedule a meeting with the SPE and Group Director, this simple factual question must be answered. Does the Marto and Lepere performance that was illustrated in applicant's disclosure in Figure 16, accurately portray the performance of the Thermoexcel-E surface following surface aging treatments C and/or D (the prior art that the Examiner relied upon)? That the Board relied on applicant's Figure 16 in its decision in regard to reversing the Examiner's rejection based on the Thermoexcel – E surface (with C and D aging) of Marto and Lepere is a conclusion not open to serious debate. What remains an open question however, and one that can only be answered by applicant and/or his test assistants, is what surface and what aging treatment of Marto and Lepere was used to generate the graphical results labeled simply "Marto and Lepere (1982)" in applicant's Fig. 16 that the Board presumed corresponded to the prior art that the Examiner was relying upon.

If the curve shown in applicant's Figure 16 does show the results for the Thermoexcel-E surface with C and/or D aging, then the Examiner intends to reconsider the prior art rejections of claims which explicitly recite the "reversal of trend of less than 2 degrees C and without a temperature overshoot on the initial ascent" limitation. Note however, that all of the claims are broader than the independent claim that the Board considered in its September 29, 2000 decision. It is submitted that none of claims 2, 5 and 10-16 contain this critical limitation that the Board based its decision on. As well,

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claim 37 contains a limitation that there is no reversal of trend, which arguably doesn't seem to even describe applicant's own disclosed invention. Res judicata and collateral estoppel only apply to claims that are identical or substantially identical to those before the Board in the parent application. The Examiner submits that none of the claims here (with the possible exception of claim 8 and even more remotely claim 37) could be passed to issue based solely on the doctrines of res judicata and/or collateral estoppel. Even those doctrines, however, do not trump a mistake of fact as this Examiner understands the law. If counsel knows of case law that holds that res judicata and/or collateral estoppel trump a mistake of fact cite it in response to this action. The Examiner would be irresponsible to his office to not inquire if the assumption made by the Board (that Applicant's Figure 16 was an accurate portrayal of the Thermoexcel-E surface with C and/or D aging) in its decision was the correct one. It serves no public purpose to repeat a mistake, if there is one, once it has been identified and the Examiner has been unable to find any case law that stands for this proposition.

In summary, applicant must be contacted to establish what surface of Marto and Lepere was tested to produce the result plotted in applicant's Figure 16 and what surface aging that surface was given to that surface prior to the test. It was the Examiner's understanding that ^{after the interview} counsel was going to set about contacting applicant in regard to the requested information about the surface and the aging and provide that information to the Examiner. In the intervening time the Examiner has not received this information or any indication of why it could not be provided.

Double patenting

Applicant appears to admit that a double patenting rejection is proper as to claims 2, 5 and 8 but apparently not as to claims 10-16 and 37. Applicant argues claims 10-16 were restricted out in a parent application but does not state why claim 37 should not be subject to terminal disclaimer. The Examiner withdraws the double patenting rejection as to claims 10-16. As to a request to defer the double patenting rejection until such time as claims 2, 5 and 8 might be allowed, the Examiner does not see a problem with that assuming applicant's statement will be carried out (expeditiously) as stated on page 6 of his June 30, 2004 response (when the Examiner asks for it). In response to this action please identify precisely where claims 10-16 were restricted out in the parent application(s).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure of any surface having "no reversal of trend." See Figure 16 of applicant's disclosure. All of applicant's surfaces have some finite reversal of trend and therefore applicant was not in "possession" of such at the time the invention was made.

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no disclosure of any surface having "no reversal of trend." See Figure 16 of applicant's disclosure. All of applicant's surfaces have some finite reversal of trend. It is submitted that applicant has provided an enabling disclosure for how to make such a surface.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeber in view of Chu and vice versa and the Marto and Lepere article and (optionally) the 1987 Hesketh dissertation.

The rejection is set forth in the Examiner's Answer, Paper No. 29 of SN 08/485,161, pages 5-15, and it is incorporated here by reference.

It is submitted that the Board may have erred in a factual manner in assuming the values found in Table 1 (specification, page 20) with respect to Marto and Lepere prior art correctly portrayed the performance of the "Aging C" and "Aging D" examples. See paragraph bridging pages 8 and 9 of the Board decision. The Board essentially ignored the fact that the Examiner was challenging the values in Table 1 of applicant's

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specification pertaining to Marto and Lepere as inaccurate with respect to the "Aging C" or "Aging D" surfaces shown in Figure 11 of Marto and Lepere. The reasons that the Examiner believes applicant's values are deemed inaccurate are set forth in the Examiner's Answer (in particularly detailed discussion on pages 9-15) incorporated here by reference. It is believed that the Board has made an error of fact their analysis, a problem with the Board decision that the Examiner found when taking up this application for examination.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 5, 8 and 37 are rejected under the judicially created doctrine of obviousness-typed double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,371,199. Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims (2, 5, 8 and 37) merely recite the invention more broadly than the corresponding claims in USP '199. The rationale

for requiring terminal disclaimer in this case is set forth In re Goodman, above. The Goodman case is incorporated here by reference.

The Examiner is requiring applicant to keep a clear line of distinction between the claims here and those found in USP '199, to avoid a statutory double patenting rejection based on the claims of USP 6,371,199. Currently, many of the dependent claims, have when read to include the limitations of the base claims and any intermediate claims appear to be substantially identical to claims found in USP 6,371,199.

Any inquiry concerning this communication should be directed to John Ford at telephone number 571-272-4911.



John K. Ford
Primary Examiner